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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861
7590	02/10/2006		EXAMINER TOMASZEWSKI, MICHAEL	
Robert C. Kowert Conley, Rose & Tayon, P.C. P.O. Box 398 Austin, TX 78767			ART UNIT 3626	PAPER NUMBER
DATE MAILED: 02/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,649

Applicant(s)

MORIMOTO, NOBUYOSHI

Examiner

Mike Tomaszewski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05 February 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 07 November 2001. Claims 1-20 are pending. The IDS statements filed on 11 February 2002, 25 June 2002, 13 January 2003, 21 January 2003, 18 August 2003, 16 December 2003 and 05 February 2004 have been entered and considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizushima et al. (US 2003/0101106; hereinafter Mizushima), in view of eHealthInsurance.com (<http://www.eHealthInsurance.com>; hereinafter eHealthInsurance), in view of Didriksen et al. (US 2001/0042055; hereinafter Didriksen).

(A) As per claim 1, Mizushima discloses a method for arranging insurance for an item, wherein the method comprises:

- (a) receiving a request to insure the item being shipped from an origination to a final destination (Mizushima: abstract; par. [0010] – [0019], [0026] – [0030], [0167] – [0181]; fig. 1, 24-27); and
- (b) generating a data file comprising at least the following:
 - (i) item information (Mizushima: abstract; par. [0010] – [0019], [0026] – [0030], [0167] – [0181]; fig. 1, 24-27);
 - (ii) insurer information (Mizushima: abstract; par. [0010] – [0019], [0026] – [0030], [0167] – [0181]; fig. 1, 24-27).

Mizushima, however, fails to expressly disclose a method for arranging insurance for an item, wherein the method comprises:

- (c) searching a database for a cost effective insurer, wherein the cost effective insurance provides a specified level of insurance coverage for the item; and
- (d) storing the data file in a memory device that accompanies the item.

Nevertheless, these features are old and well known in the art, as evidenced by eHealthInsurance and Didriksen. In particular, eHealthInsurance and Didriksen disclose a method for arranging insurance for an item, wherein the method comprises:

- (c) searching a database for a cost effective insurer, wherein the cost effective insurance provides a specified level of insurance coverage for the item (eHealthInsurance: Corporate Overview); and
- (d) storing the data file in a memory device that accompanies the item (Didriksen: abstract; par. [0035]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of eHealthInsurance with the teachings of Mizushima with the motivation of providing a means for comparing various insurers (eHealthInsurance: Corporate Overview).

Moreover, One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Didriksen with the combined teachings of Mizushima and eHealthInsurance with the motivation of providing a means for shipping items (Didriksen: abstract; par. [0012] – [0018]).

(B) As per claim 2, Mizushima discloses the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (Mizushima: abstract; par. [0141] – [0167]; fig. 14-16).

(C) As per claim 3, Mizushima discloses the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (Mizushima: abstract; par. [0203]; fig. 29-30).

(D) As per claim 4, Mizushima discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company (Mizushima: abstract; par. [0072] – [0076]; fig. 1).

(E) As per claim 5, Mizushima discloses the method as recited in claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses (Mizushima: abstract; par. [0077], [0172], [0186], [0212]; fig. 1).

(F) As per claim 6, Mizushima discloses the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server (Mizushima: abstract; [0091] – [0110]; fig. 1-2).

Art Unit: 3626

(G) As per claim 7, Mizushima discloses the method as recited in claim 1, further comprising shipping the item using the least expensive routing (Mizushima: abstract; par. [0010] – [0019], [0026] – [0030], [0167] – [0181]; fig. 1, 24-27).

(H) As per claim 8, Mizushima discloses the method as recited in claim 1, wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item (Mizushima: abstract; par. [0010] – [0019], [0026] – [0030], [0167] – [0181]; fig. 1, 24-27).

(I) As per claim 9, Mizushima discloses the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (Mizushima: abstract; par. [0022] – [0024], [0091] – [0110]; fig. 1-2).

(J) As per claim 10, Mizushima discloses the method as recited in claim 1, wherein storing the data file comprises data in an XML format (Mizushima: par. [0112], [0197]).

(K) As per claim 11, Mizushima discloses the method as recited in claim 1, wherein the network data is exchanged in an XML format (Mizushima: par. [0112], [0197]).

Art Unit: 3626

(L) As per claim 12, Mizushima fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises item weight information (Didriksen: abstract; par. [0027]).

(M) As per claim 13, Mizushima discloses the method as recited in claim 1, wherein the data file further comprises item handling information (Mizushima: abstract; par. [0022] – [0035]).

(N) As per claim 14, Mizushima discloses the method as recited in claim 1, wherein the data file further comprises item content information (Mizushima: abstract; par. [0022] – [0035]).

(O) As per claim 15, Mizushima discloses the method as recited in claim 1, wherein the data file further comprises insurance information (Mizushima: abstract; par. [0022] – [0035]).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizushima, eHealthInsurance, and Didriksen as applied to claim 1 above, and further in view of eBay (<http://www.ebay.com>; hereinafter eBay).

Art Unit: 3626

(A) As per claim 16, Mizushima fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping.

Nevertheless, this feature is old and well known in the art, as evidenced by eBay. In particular, eBay discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping (eBay: Why eBay is Safe; How to Add a Photo to Your Item Listing).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of eBay with the combined teachings of Mizushima, eHealthInsurance and Didriksen with the motivation of providing a means for archiving the condition of an item for insurance claims purposes (eBay: Why eBay is Safe).

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizushima, eHealthInsurance, and Didriksen as applied to claim 1 above, in further view of Chen et al. (5,504,674; hereinafter Chen), and further in view of knowledge generally available to one having ordinary skill in the art.

(A) As per claim 17, Mizushima fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

Nevertheless, this feature is old and well known in the art, as evidenced by Chen and knowledge generally available to one having ordinary skill in the art. In particular,

Art Unit: 3626

Chen discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (Chen: abstract). Furthermore, taking photographs of items to document the physical condition of the items at different time frames (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known. For example, customers of parcel carriers, such as, FedEx™ and UPS™, are advised to document (e.g., photograph) any damage to their parcels/goods upon receipt in order to ensure successful insurance claims. Another example involves car rental agencies. Before a customer rents a vehicle from a car rental agency the agency meticulously documents the condition of a vehicle. Upon return of the vehicle, the car rental agency will photograph any damage to their vehicle to maintain the proper documentation for insurance claims purposes.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Chen and knowledge generally available to one having ordinary skill in the art with the combined teachings of Mizushima, eHealthInsurance and Didriksen with the motivation of providing a means for assessing damage for insurance claim processing purposes (Chen: abstract).

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizushima, eHealthInsurance, and Didriksen as applied to claim 1 above, and further in view of Kepler (5,347,845; hereinafter Kepler).

Art Unit: 3626

(A) As per claim 18, Mizushima fails to expressly disclose the method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

Nevertheless, this feature is old and well known in the art, as evidenced by Kepler. In particular, Kepler discloses the method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file (Kepler: abstract; col. 2, lines 25-35).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kepler with the combined teachings of Mizushima, eHealthInsurance and Didriksen with the motivation of detecting the presence of contaminants in shipping containers (Kepler: col. 2, lines 33-35).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a multi-stage parcel tracking system (6,285,916); a method and apparatus for Internet on-line insurance policy service (US 2002/0116228); an integrated suite of products/services for conducting business online (US 2002/0198744); a method for selling marine cargo insurance in a network environment (US 2002/0156656); providing cargo insurance in a

Art Unit: 3626

full service trade system (US 2002/0107785); and personnel and asset tracking method and apparatus (6,344,794).

The cited but not applied prior art also includes non-patent literature articles by Hubbard, C. T. ("Registered Mail Transit Insurance" Dec 27, 1943. Barron's National Business and Financial Weekly. Vol. 23, Iss. 52. pg. 20.); Business Wire ("WebTradeInsure First to Provide Comprehensive e-Marketplace Internet Fraud Protection Services for Online Auction and Business Exchange Transactions" Jul 11, 2000. pg. 1.); Thurston, Scott ("UPS sued over fee for parcel insurance" Nov 20, 1999. The Atlanta Journal The Atlanta Constitution. pg. D.1.); PR Newswire ("Global Souces and dollarDEX Establish Online Cargo Insurance Services" Sep 28, 2000. pg. 1.); PR Newswire ("E-Stamp Corporation Announces Aggressive Strategy for Growth" May 12, 2000. pg. 1.); Rucker, John ("Recognize Your Risks" Nov 1994. Transportation & Distribution. Vol. 35, Iss. 11. pg. 55.); Hickey, Kathleen ("Internet Care" Jul 17, 2000. Journal of Commerce. pg. 23.); Strazewski, Len ("Picture This" Sep 2000. Rough Notes. Vol. 143, Iss. 9. pg. 108.); and Anonymous ("A picture is worth a thousand dollars" Feb 1994. Distribution. Vol. 93, Iss. 2. pg. 12.).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

Art Unit: 3626


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT



2.3.06



C. LUKE GILLIGAN
PATENT EXAMINER